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EXAMINER

WOO, STELLA L

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/505,915

Applicant(s)

KATZ, RONALD A.

Examiner

Stella L. Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-23,25-40,42-116,121 and 123-205 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-23,25-28,39,40,42-58,63-76,86-106,111-116,121,123-170,180-200 and 205 is/are rejected.
- 7) ☒ Claim(s) 29-38,59-62,77-85,107-110,171-179 and 201-204 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 21-22, 25, 69-70, 72, 116, 121, 123, 163-165 and 167-170 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for same reasons given in the last Office action and repeated below. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claims 21-23, 69-70, 72, 116, 121, 123, 163-165, 167-170 recite isolating or communication with a select vendor site based on purchase, cost or price data. However, the specification does not describe such isolating of a vendor using purchase, cost or price data. On page 8, line 6-8, the specification describes a buyer soliciting proposals for a particular item from vendors qualified for the designated merchandise. On page 12, lines 10-12 describe transmitting buyer requests for proposals only to vendors designated to sell the merchandise. On page 18, lines 2-10 describe regulating communication using merchandise codes which indicate the type of products each vendor is authorized to sell. Applicant argues that the request form of Figure 9 includes price data. However, the request form is transmitted to vendors who are authorized to sell the designated merchandise, as identified by the merchandise code on the request form. There is no description of the control system isolating or communicating with vendors based on

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purchase, cost or price data. It is the vendors which receive the price data on the request form. There is no description of the control system utilizing purchase, cost or price data, as recited in the above-identified claims.

Claim 25 recites the control system determining a highest offer. The examiner fails to find any support in the specification.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 17-20, 23, 26-28, 39-40, 42-58, 63-68, 71, 73-76, 86-106, 111-115, 124-162, 166, 180-200, 205 are rejected under 35 U.S.C. 102(e) as being anticipated by Lockwood (US 5,576,951).

Regarding claims 17-20, 39-40, 42-58, 63-68, 73, 111, 159-162, 166, 180-200, 205, Lockwood discloses an electronic commercial transaction system (automated sales and services system; Fig. 12) for selectively enabling communications via a communication network (telephone network 280, telecommunications network service 205) between at least one or more buyers (customer terminal 202) and at least one of a plurality of vendor sites (goods and services providers 204), at least certain of said buyers

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having addresses for electronic communication (each customer television receiver 274 has its own specific address code; col. 17, lines 24-42), comprising:

an interface (central data processing center 201 provides an interface for facilitating a transaction between interested buyers 202 with a vendor site 204 via an on-line computer service TELENET 205; col. 16, lines 43-67; col. 19, lines 7-9);

an input system (customers 202 can designate an area of commercial merchandise or services interest to a voice response system 221 using a tone generating keypad 276 of a dial tone telephone 275 to select from a general menu categories such as retail, travel, financial and grocery; Fig. 17; col. 17, lines 3-14; col. 19, lines 40-51; col. 20, lines 13-29, 61-64);

a control system (central processor 222 selects the appropriate data source associated with the customer's request; col. 18, lines 51-54; col. 19, lines 52-53; col. 20, lines 36-39);

a memory (memory 223 stores sales data transacted for each company, the data being forwarded to the appropriate service provider 204 via TELENET 205; Fig. 12; col. 22, lines 30-56),

whereby the control system electronically outputs (central processor outputs a selected high-resolution audio-visual presentation to a customer's terminal 202; col. 18, lines 9-56; col. 19, lines 52-57).

Upon acceptance of a customer's order, the central data processing center transmits to the customer's station a confirmation number (col. 19, lines 4-6).

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Regarding claims 23, 26-28, 71, 74-76, 112-115, 124-158, the vendors are selected based on the type of product or service selected by the customer (col. 7, lines 29-52; col. 23, lines 19-32).

***Allowable Subject Matter***

5. Claims 29-38, 59-62, 77-85, 107-110, 171-179, 201-204 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The claims recite allowable subject matter because the prior art does not teach or fairly suggest outputting an indication to a buyer via an electronic mail communication.

***Response to Arguments***

6. Applicant's arguments filed June 8, 2004 have been fully considered but they are not persuasive.

Applicant argues that a merchandise code can be considered as "purchase data." However, the specification does not define or describe merchandise codes as purchase data. For example, on page 40 of applicant's specification, a merchandise code is used to determine the type of products to which a vendor is authorized to access. It cannot be considered as "purchase data" in that it does not relate to a purchase.

Applicant argues that Figure 9 shows cost data, which is communicated to a vendor. However, the claims recite the "control system...utilizing...cost data." The request form, which includes the desired cost data, is transmitted to vendors who are authorized to sell the designated merchandise, as identified by the merchandise code on

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the request form. The control system utilizes the merchandise code, not the desired cost data, in isolating and communicating with vendors. There is no description of the control system isolating or communicating with vendors utilizing purchase, cost or price data. It is the vendors which receive the price data on the request form, not the control system.

Regarding the Lockwood patent, the data on areas of interest include a customer's selection from a menu of general categories of products and services including: retail, travel, financial and grocery (col. 20, lines 61-64). The customer can also enter a numbered key associated with a specific product (col. 20, lines 26-28).

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella L. Woo whose telephone number is (703) 305-4395. The examiner can normally be reached on Monday-Tuesday, Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703) 305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Stella L. Woo  
Primary Examiner  
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